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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,752	12/11/2000	Janet A. Warrington	3308.3	4824

22886 7590 08/25/2003

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EXAMINER

SPIEGLER, ALEXANDER H

ART UNIT	PAPER NUMBER
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1637

17

DATE MAILED: 08/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/734,752

Applicant(s)

WARRINGTON ET AL.

Examiner

Alexander H. Spiegler

Art Unit

1637

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 July 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION: See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 2 and 4-9.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

Continuation of 2. NOTE:

2(a)

1) Applicants have amended Claim 2 to recite "A method for diagnosing disease in a female subject", however, previously Claim 2 did not require this limitation (e.g., diagnosing exclusively in a female subject), and therefore, further search and consideration would be required for "diagnosing disease in a female subject".

2) Applicants have amended Claim 4 to recite, "wherein all the reference samples in the plurality share at least one indicator of reproductive status in common", ~~"wherein each of the reference samples have been diagnosed with the same physiological disorder",~~ and "wherein the experimental sample also shares the at least one indicator of reproductive status". All of these additional limitations were not present in the previous claims, and therefore these limitations require further search and consideration.

3) Applicants have amended Claim 6 to recite "A method to identify markers of different reproductive states in women" by obtaining expression profiles from samples in a first and second "reproductive state". Previously, the claim was drawn to identifying markers of reproductive states by obtaining expression profiles from physiological states, and not reproductive states. Accordingly, because Applicants amendments change the claim to obtain expression profiles from reproductive states (versus physiological states), the amendment would require further search and consideration.

2(b) Applicants have amended the specification (beginning page 5, line 21; see page 2 of Applicants amendment detailing the additions) by adding additional passages that were not present, nor supported by original specification. It is also noted that Applicants do not provide any citation of the original specification that support these additions.

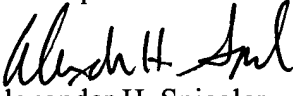
Continuation of 5. does NOT place the application in condition for allowance because of the reasons of record, in view of the non-entry of the amendment filed on July 28, 2003.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander H. Spiegler whose telephone number is (703) 305-0806. The examiner can normally be reached on Monday through Friday, 7:00 AM to 3:30 PM.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (703) 308-1119. The fax number for the organization where this application or proceeding is assigned is (703) 872-9306. Applicant is also invited to contact the TC 1600 Customer Service Hotline at (703) 308-0198.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.


Alexander H. Spiegler
August 21, 2003


GARY BENZION, PH.D.
SUPERVISORY PATENT EXAMINER
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